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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,743	08/08/2001	Mark Ross	14101	2934

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DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER

HONG, JOHN C

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/924,743	Applicant(s) ROSS, MARK	
	Examiner John C. Hong	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982), *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, and 3-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-30 of copending Application No. 10/304,820. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to the same general structure a sheet that suppresses "Newton Rings" where by the same materials are

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used. in fact, dependent claims in the There is merely some minor variation between the independent claims and they could not support separate patents

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshima (U.S. Patent 6,592,950).

Toshima et al. teach : coatings (2) used on plastic films (1) wherein the coatings can be applied non-uniformly (Figure 1) or uniformly (Figure 2). he base layer (1) can be a biaxially oriented polyester film" (i.e. polyethylene terephthala) among others (column 3, lines 32+ and the examples). The examples show films having a thickness of 100 microns (approximately 4 mils, corresponding to applicants' claim 12, 13, 26, and 27);

The coating (2) comprises a resin base (3) comprising acrylic or methacrylic monomers (resins) (column 4, lines 45+), and particles (4). Examples of the particles include resin or glass beads (column 5, lines 36). Glass is made from silica. The beads have an average particle size in the range of 1-30 microns, which is with in the claimed range;

The films can comprise a protective "hard coating layer" opposite coating (2) corresponding to the applicants "scratch resistant coating" (Applicants' claims 13, 14, and 28);

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The applicant claims a method of using a film to reduce "Newton Rings", Toshima et al. teach that the films of their invention would be used as a "Protective Film" on a liquid crystal display as a "Anti-Newton Ring Film";

Toshima et al. teach films used to prevent "Newton Rings" and are made of the same materials as applicant's films. The films have a textured surface so they function in the same capacity as applicant's films and they are used as protective films for liquid crystal displays. The essential differences between the films are: details about how to use the film, placing the film in the gap between the gap in the screen and the case, the particulars of the filler, the addition of an anti-glare coating and packaging the film with instructions.

It would have been obvious to one having ordinary skill in the art to have used the films taught by Toshima et al. as protective films for personal digital assistants (PDA), which have, LCD screens so that the screen can be protected.

It also appears that the layer would be coextensive with the screen and if installed at the factory would be under the case in use.

It would have been obvious to one having ordinary skill in the art to have placed the protective film between the screen and the case since adhesives could damage the surface of the LDC screen. This film could be simply overlaid over the screen and mechanically retained in place by the same frame that holds the screen in place.

Regarding the choice of particles. All particles work to prevent Newton rings by the same mechanism; they prevent the surface of the film from touching the surface of the screen. Since the nature of the particles does not appear to be critical for this function, it would have been obvious to one having ordinary skill in the art to have used any form of particles as long as

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they did not scratch the surface of the screen.

Regarding the use of an anti-glare coating. It is conventional to use anti-glare coatings on the surface of optical articles including articles such as LCD screens, thus it would have been obvious to one having ordinary skill in the art to have place an antiglare coating on the surface of the films. Since the coating is known by the properties it exhibits, the name itself establishes that there is recognition in the art of how it functions. One working in the art would understand that it solves the problem of glare and how to use it. The applicants do not require any particular materials so they to recognize a certain level in the art attributed to the phrase "anti-glare coating" too.

Response to Arguments

5. Applicant's arguments filed 10/18/04 have been fully considered but they are not persuasive. Applicant's argument about the utilizing adhesive layer. But Toshima et al. do not state that an adhesive is used.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John C. Hong whose telephone number is 571-272-4529. The examiner can normally be reached on M-F(07:00-16:30)First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John C. Hong
Primary Examiner
Art Unit 3726

jh
6 January, 2005